

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEPHEN F. BAUMANN,
ROBERT E. SANDERS, JR.,
and
SCOTT L. PALMER

Appeal No. 1999-0130
Application No. 08/439,035

ON BRIEF

Before WARREN, TIMM, and DELMENDO, Administrative Patent Judges.

DELMENDO, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the examiner's refusal to allow claims 1, 3 through 7, 10, 12 through 14, 16, 17, 19, and 21 through 23, which are all of the claims pending in the above-identified application.¹

¹ In reply to the final Office action of September 2, 1997 (paper 8), the appellants submitted an amendment under 37 CFR § 1.116 (1997) on March 6, 1998 (paper 9), proposing the cancellation of claims 9, 11, 18, and 20 and changes to claims 1

The subject matter on appeal relates to a method of producing a motor vehicle body panel from aluminum alloy sheet. Further details of this appealed subject matter are recited in illustrative claims 1 and 14 reproduced below:

1. A method of producing a motor vehicle body panel from aluminum alloy sheet comprising,
roll casting an aluminum alloy strip having a thickness of less than about 0.5 inch,
cold rolling said strip to a thickness of less than about 0.15 inch,
effecting said cold rolling of said cast strip without prior thermal treatment of said roll cast strip,
subjecting said cold rolled strip to continuous annealing at a temperature of about 750°F to 1000°F for about 1 to 60 seconds,
subsequent to said continuous annealing converting said strip into a motor vehicle body panel, and
said aluminum alloy being an alloy selected from the group consisting of 3XXX and 5XXX.

14. A method of producing a motor vehicle body panel from aluminum alloy sheet comprising,
roll casting an aluminum alloy strip having a thickness of less than about 0.5 inch,
cold rolling said strip to a thickness of less than about 0.15 inch,
effecting said cold rolling of said roll strip without prior thermal treatment of said cast strip,
subjecting said cold rolled strip to solution heat treatment at a temperature of about 800°F to 1100°F for about 1 to 60 seconds,

and 14. According to the advisory action of March 26, 1998 (paper 10), the amendment has been entered.

subsequent to said solution heat treatment
converting said strip into a motor vehicle body panel,
and

said aluminum alloy being an alloy selected from
the group consisting of 2XXX and 6XXX.

The examiner relies on the following prior art references
as evidence of unpatentability:

Ward et al. (Ward)	5,503,689	Apr. 2, 1996 (filed Apr. 8, 1994)
Habu et al. (Habu)	5,516,374	May 14, 1996 (filed May 4, 1994)
Nishikawa et al. (Nishikawa)	5,562,784	Oct. 8, 1996 (filed Dec. 7, 1994)
Erickson et al. (Erickson)	5,582,660	Dec. 10, 1996 (filed Dec. 22, 1994)

Claims 1, 3 through 7, 10, 12 through 14, 16, 17, 19, and
21 through 23 on appeal stand rejected under 35 U.S.C. § 103(a)
as unpatentable over Nishikawa in view of either Habu or
Erickson. (Examiner's answer, pages 3-5.) Also, claims 1, 3
through 7, 10, 12 through 14, 16, 17, 19, and 21 through 23 on
appeal stand rejected under 35 U.S.C. § 103(a) as unpatentable
over either Habu or Erickson in view of either Nishikawa or
Ward. (Id. at pages 5-6.)

We reverse these rejections.

Prior to addressing the merits of the examiner's rejections, it is important to emphasize that the initial burden of establishing a prima case of obviousness within the meaning of 35 U.S.C. § 103 rests on the examiner. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). In addition, to properly reject claims under 35 U.S.C. § 103 as prima facie obvious in view of a combination of prior art references, an examiner must consider, inter alia, two factors: (1) whether the prior art would have suggested to one of ordinary skill in the art to make the claimed composition or carry out the claimed process; and (2) whether the prior art would also have revealed that, in so making or carrying out, the person of ordinary skill would have had a reasonable expectation of success. In re Vaeck, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991) (citing In re Dow Chemical Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988)). Both the suggestion and reasonable expectation of success must be founded in the prior art, not in applicants' disclosure. Id.

In this case, we determine that the examiner has not met the threshold burden of proof because neither the suggestion nor the requisite reasonable expectation of success is founded in the prior art. Id.

Concerning the rejection based on Nishikawa in view of either Habu or Erickson, the examiner admits that Nishikawa's process differs from the invention recited in the appealed claims in three respects. (Id. at page 4.) One of these differences is said to be that Nishikawa does not describe the specific alloys recited in appealed claims 1 and 14, the only independent claims in the application. To account for this difference, the examiner takes the following position:

With respect to the alloy compositions, appellant does [sic, appellants do] not allege any novelty of the compositions recited in the process of the appealed claims, and the Erickson and Habu references, respectively, recite performing their disclosed processes upon 2XXX and 5XXX compositions. See the examples of Erickson or Table 1 of Habu. (It is the examiner's understanding that 2XXX alloys are those which contain copper as a significant alloying element, 3XXX alloys contain manganese as a significant alloying element, 5XXX alloys contain magnesium, and 6XXX alloys contain both magnesium and silicon). [Id. at pp. 4-5.]

In response to the appellants' arguments that Nishikawa teaches the use of a different type of alloy for a different purpose and that one of ordinary skill in the art would have been led away from using the here claimed alloys in Nishikawa (appeal brief, pages 5-6), the examiner states:

Admittedly, the Nishikawa process is not drawn to a process involving the 2XXX, 3XXX, 5XXX, or 6XXX alloy families specified in the appealed claims. However, it should be noted that the appealed claims

are drawn to processes, not products, and that no novelty has been alleged by appellant[s] of [sic, for] the alloy compositions themselves. [Examiner's answer, p. 7; emphasis added.]

From our perspective, the examiner's comments are inapposite to an analysis on whether the claimed subject matter as a whole would have been prima facie obvious, within the meaning of 35 U.S.C. § 103, to one of ordinary skill in the art over the collective teachings of the applied prior art references. That the recited alloys may be old is insufficient to establish that one of ordinary skill in the art would have been led by the teachings of the applied prior art to arrive at the claimed invention. In re Warner, 397 F.2d 1011, 1016, 154 USPQ 173, 177 (CCPA 1967) ("[W]here the invention sought to be patented resides in a combination of old elements, the proper inquiry is whether bringing them together was obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention from elements of the prior art."); In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ("[T]he Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious."); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir.

1999) ("[T]he best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.").

Not only is there no teaching, motivation, or suggestion to combine the references, there is also no indication that one of ordinary skill in the art would have had a reasonable expectation of success in replacing the alloys described in Nishikawa with the recited alloys as proposed by the examiner. Vaeck, 947 F.2d at 493, 20 USPQ2d at 1442; In re O'Farrell, 853 F.2d 894, 904, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988).

Thus, it is our judgment that the examiner has not established a prima facie case of obviousness within the meaning of 35 U.S.C. § 103. As a consequence, we cannot uphold the examiner's rejection on this ground.

With respect to the examiner's rejection based on Habu or Erickson in view of either Nishikawa or Ward, the examiner states:

The processes of Habu and Erickson differ from those as recited in the appealed claims in that Habu and Erickson do not recite the required "roll casting" step of the appealed claims followed by cold rolling without an intermediate thermal treatment. Nishikawa and Ward both indicate that such preliminary steps in forming aluminum alloy sheets are conventional in the art...Given that all of the cited prior art is drawn

to processes of casting, cold rolling, and heat treating of aluminum alloys, it would have been an obvious expedient to one of ordinary skill in the art to prepare the alloy sheets which are to be processed by the methods of Habu or Erickson by the casting and working steps as described by Nishikawa or Ward. [Examiner's answer, pp. 5-6.]

In response to the appellants' argument that neither Habu nor Erickson teaches the roll casting step recited in the appealed claims, the examiner alleges:

In the present case, novelty does not reside in any particular method of casting, and pages 1-2 of the present specification indicate that roll casting, as understood by appellants, was in fact known in the art prior to the present invention. The examiner simply fails to see how the substitution of one known casting process for another (both being types of casting disclosed in the art used in the rejections) involves a destruction of the teachings of any individual reference...[Id. at p. 9.]

Again, however, the fact that roll casting is "known in the art" is insufficient to establish that one of ordinary skill in the art would have been led to modify Habu or Erickson to feature a roll casting step. Warner, 397 F.2d at 1016, 154 USPQ at 177.

Also, the examiner has not established that one of ordinary skill in the art would have modified the process of Habu or Erickson to include a roll casting step with a reasonable expectation of success. Vaeck, 947 F.2d at 493, 20 USPQ2d at 1442; O-Farrell, 853 F.2d at 904, 7 USPQ2d at 1681.

Appeal No. 1999-0130
Application No. 08/439,035

For these reasons, we likewise cannot uphold the examiner's rejection on this ground.

In summary, we reverse the examiner's rejections under 35 U.S.C. § 103(a) of all the appealed claims as unpatentable over (i) Nishikawa in view of either Habu or Erickson or (ii) either Habu or Erickson in view of either Nishikawa or Ward.

The decision of the examiner is reversed.

REVERSED

CHARLES F. WARREN)	
Administrative Patent Judge)	
)	
)	
)	
)	BOARD OF PATENT
CATHERINE TIMM)	
Administrative Patent Judge)	APPEALS AND
)	
)	INTERFERENCES
)	
)	
ROMULO H. DELMENDO)	
Administrative Patent Judge)	

RHD/kis

Appeal No. 1999-0130
Application No. 08/439,035

ARNOLD B. SILVERMAN
ECKERT, SEAMANS, CHERIN & MELLOTT
600 GRANT STREET
FORTY SECOND FLOOR
PITTSBURGH, PA 15219